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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,387

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Scott V. Taylor

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APPLIED MEDICAL RESOURCES CORPORATION

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EXAMINER

NGUYEN, TUAN VAN

ART UNIT

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3731

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/776,387	Applicant(s) TAYLOR ET AL.	
	Examiner Tuan V. Nguyen	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 and 67 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10, 11, 13, 14, 26-30, 32-46, 49-53, 55-63 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 12, 15-25, 31, 47, 48, 54 and 64-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/29/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment After Non-Final Rejection

1. According to the Amendment after Non-Final Rejection applicant filed on August 22, 2007 in response to the Office action mailed out on June 5, 2007, claims 12 and 24 are amended to correct inadvertent grammatical errors and claims 64-66 are canceled.

Response to Amendment

2. Applicant's arguments filed on August 22, 2007 with respect to that Gentile reference fails to disclose the roller having properties for forming an instrument seal in the presence of an instrument have been fully considered and persuasive therefore the previous rejection is hereby withdrawn. However, upon further search and consideration the pending claims are stand rejected in view of the new grounds of rejections.

Elections/Restrictions

3. Claim 55 recites the limitation of "inflatable bladder" which does not read on the elected invention therefore it is being withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions. Noting that in previous Office action, claims 6, 10, 11, 13, 14, 26-30, 32-42, 43-46, 49-53,

and 56-63 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24, 25, and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 24 recites the limitation "a resilient material included in the roller and having properties susceptible to tearing in response to an instrument inserted into the working channel". Nowhere in the specification does applicant disclose the resilient material that susceptible to tearing. Examiner understood that the applicant intended to recite the resilient material is not susceptible to tearing and will be considered as such for examination purposes.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 15, 24, 47 and 48 are rejected under 35 U.S.C. 112, second paragraph because theses claims recite limitation "zero seal in the absence of the

instrument, and an instrument seal in the presence of the instrument” is unclear thereby rendering the scope of the claim(s) unascertainable. Examiner interprets the limitation as a gas tight seal in the absence of the instrument and a gas or fluid tight seal in the presence of the instrument. Claims 2, 3, 4, 5, 7-9, 12, 16-23, 25, 31, and 54 are also rejected as dependent from the rejected claim(s).

6. Claim 18 is rejected because it recites limitation “zero seal” is unclear thereby rendering the scope of the claim(s) unascertainable. Examiner interprets the limitation as a gas tight seal or fluid tight seal.
7. Claim 9 is rejected because it recites limitation “the instrument seal having a diameter with a lower limit of about zero millimeters” is unclear thereby rendering the scope of the claim(s) unascertainable. The limitation “zero millimeters” indicates that the instrument does not exist or the portion that inserted into the trocar does not exist.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1, 2, 4, 5, 7, 8, 9, 12, 15, 17, 18, 21, 22, and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Gravener et al (U.S. 5,360,417).**

10. Referring to claims **1, 2, 4, 5, 7, 8, 12, 15, 17, 18, 21, 22, and 47-48**, Gravener discloses (see Figs. 22 and 23) a trocar adapted to provide access for a surgical instrument through a body wall and into a body cavity (see Summary of The Invention), comprising: a cannula 64 having a proximal end and a distal end; a seal housing, which contains valve 10 assembly, communicating with the cannula to define a working channel; a seal assembly includes valve 10 and rollers 96 disposed within the seal housing; two pinching members or rollers 96, wherein each having an axle supported by the seal housing; and the rollers having properties for forming a gas tight seal or fluid tight seal with or without the presence of an instrument (see col. 8, lines 10-40).
11. Referring to **claim 9**, Gravener discloses the valve assembly 10 is designed to accommodate and provide a seal about instrument of varying diameters e.g., diameters of from 3mm to 15 mm (see col. 5, lines 10-16).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
14. **Claims 3 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gravener et al (U.S. 5,360,417).**
15. Referring to claim 3, Gravener discloses the invention substantially as claimed except for the axle has a fixed relationship with the seal housing and the roller has a pivotal relationship with the axle. However, Figure 22 of Gravener's drawings discloses such a mechanism. Figure 22 discloses the pinching member has a pivotal relationship with the axle 88, wherein axle 88 is fixed with respect to the housing. Therefore, it would have been obvious to one of ordinary skill in the art to perform a simple substitution of one known element for another to obtain predictable results.
16. Referring to claim 23, Gravener discloses the invention substantially as claimed except for the housing and the roller are formed of translucent material. However, it is old and well known in the art that trocar housing and cannula are formed of translucent or transparent material is for the purpose of providing the surgeons the ability to observe the tissue and the location of the distal tip of the instrument being

inserted into the cavity. Extrinsic evidence, Frederick et al (US 6,017,356) discloses the trocar 40 is made from transparent material for the purpose of providing the surgeons the ability to observe the tissue (see Example 2).

17. **Claims 16, 19, 20, 24, 25, 31, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gravener et al (U.S. 5,360,417) in view of De la Torre et al (US . 6,238,373).**
18. Gravener discloses the invention substantially as claimed except for the roller includes a gel material. However, De la Torre discloses such a material for his device (see col. 10, line 52 to col. 11, line 15 and Fig. 16-16a). Apparently the gel material provides a better compliant between the valve and the outer surface of the instrument thereby providing a better seal between the valve and the instrument. Therefore, it would have been obvious to one of ordinary skill in the art to include the gel material around the rollers 96 so that it too would have the same advantage.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/776,387
Art Unit: 3731

Page 8

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan V. Nguyen
December 14, 2007



Todd E. Manahan
SPE 3731